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6 AEROFLEX, INC.,  
MATROX TECH SEMICONDUCTOR, INC.,  
7 MATROX ELECTRONIC SYSTEMS, LTD.,  
MATROX GRAPHICS INC.,  
8 MATROX INTERNATIONAL CORP.,  
MATROX TECH, INC. and  
9 AEROFLEX COLORADO SPRINGS, INC.

10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA  
12 SAN FRANCISCO DIVISION  
13

14 RICOH COMPANY, LTD.,

15 Plaintiff,

16 vs.

17 AEROFLEX INCORPORATED, MATROX TECH  
18 SEMICONDUCTOR, INC., MATROX  
ELECTRONIC SYSTEMS, LTD., MATROX  
19 GRAPHICS INC., MATROX  
INTERNATIONAL CORP., MATROX TECH,  
20 INC., and AEROFLEX COLORADO SPRINGS,  
INC.,

21 Defendants.  
22

Case No. CV 03-04669 MJJ (EMC)

**AMENDED ANSWER AND  
COUNTERCLAIMS OF DEFENDANT  
MATROX TECH INC. TO AMENDED  
COMPLAINT FOR PATENT  
INFRINGEMENT**

23 Defendant Matrox Tech, Inc. ("Matrox Tech") for its Amended Answer to the Amended  
24 Complaint and for its Counterclaims, hereby responds to the numbered paragraphs of the Amended  
25 Complaint filed by Ricoh Company, Ltd. ("Rico"), and in doing so denies the allegations of the  
26 Amended Complaint except as specifically stated:  
27  
28

**PARTIES**

1  
2           1.       Upon information and belief, Matrox Tech admits that plaintiff Ricoh is a corporation  
3 organized under the laws of Japan and maintains its principal place of business at 3 -6 1-chome,  
4 Nakamagome, Tokyo, Japan.

5           2.       Matrox Tech lacks information sufficient to form a belief as to the truth of the  
6 allegations of Paragraph 2, and on that basis, denies those allegations.

7           3.       Matrox Tech admits that Matrox Tech is a corporation organized under the laws of  
8 Delaware and maintains its principal place of business at 2300 Buckskin Road, Pocatello, ID, 83201.  
9 Matrox Tech admits that Matrox Tech has consented to the jurisdiction of Court. Except as expressly  
10 admitted, Matrox Tech denies the allegations of Paragraph 3 of the Amended Complaint.

11          4.       Matrox Tech lacks information sufficient to form a belief as to the truth of the  
12 allegations of Paragraph 4, and on that basis, denies those allegations.

13          5.       Matrox Tech lacks information sufficient to form a belief as to the truth of the  
14 allegations of Paragraph 5 of the Amended Complaint.

15          6.       Matrox Tech lacks information sufficient to form a belief as to the truth of the  
16 allegations of Paragraph 6, and on that basis, denies those allegations.

17          7.       Matrox Tech admits Matrox Tech is a corporation organized under the laws of  
18 Delaware, and maintains its principal place of business at 1075 Broken Sound Parkway, NW, Boca  
19 Raton, FL 333487-3524. Matrox Tech admits that Matrox Tech has consented to the jurisdiction of  
20 this Court for this action. Except as expressly admitted, Matrox Tech denies the allegations of  
21 Paragraph 7 of the Amended Complaint.

22          8.       Matrox Tech lacks information sufficient to form a belief as to the truth of the  
23 allegations of Paragraph 8, and on that basis, denies those allegations.

**JURISDICTION**

24  
25          9.       Matrox Tech admits that plaintiff's claim purports to arise under the patent laws of the  
26 United States, Title 35, and more particularly under 35 U.S.C. §§ 271 et. seq. Except as expressly  
27 admitted, Matrox Tech denies the allegations of Paragraph 9 of the Amended Complaint.

1           10.     Matrox Tech admits that the Court has subject matter jurisdiction over the allegations of  
2 patent infringement in the Amended Complaint pursuant to 28 U.S.C. §§ 1338(a) and 1331. Except as  
3 expressly admitted, Matrox Tech denies the allegations of Paragraph 10 of the Amended Complaint.

4           11.     Matrox Tech admits that the Court has personal jurisdiction over Matrox Tech. Except  
5 as expressly denied, Matrox Tech denies the allegations of Paragraph 11 of the Amended Complaint.

### 6                                   **VENUE**

7           12.     Matrox Tech admits that venue is proper in this judicial district pursuant to 28 U.S.C. §  
8 1391. Except as expressly admitted, Matrox Tech denies the allegations of Paragraph 12 of the  
9 Amended Complaint.

### 10                               **FACTUAL BACKGROUND**

11           13.     Matrox Tech admits that United States Patent No. 4,922,432 (“the ‘432 Patent”) entitled  
12 “Knowledge Based Method and Apparatus for Designing Integrated Circuits using Functional  
13 Specifications,” issued on May 1, 1990. Matrox Tech admits that the ‘432 Patent names Hideaki  
14 Kobayashi and Masahiro Shindo as inventors. Matrox Tech further admits that a copy of the ‘432  
15 Patent is attached to the Amended Complaint as Exhibit 1. Except as expressly admitted, Matrox Tech  
16 denies the allegations of Paragraph 13 of the Amended Complaint.

17           14.     Matrox Tech lacks information sufficient to form a belief as to the truth of the  
18 allegations of Paragraph 14, and on that basis, denies those allegations.

19           15.     Matrox Tech lacks information sufficient to form a belief as to the truth of the  
20 allegations of Paragraph 15, and on that basis, denies those allegations.

### 21                               **PATENT INFRINGEMENT**

#### 22                               **COUNT 1**

23           16.     Matrox Tech repeats its responses to the allegations in Paragraphs 1 through 15 of the  
24 Amended Complaint.

25           17.     Matrox Tech lacks information sufficient to form a belief as to the truth of the  
26 allegations of Paragraph 17, and on that basis, denies those allegations.

27           18.     Matrox Tech lacks information sufficient to form a belief as to the truth of the  
28 allegations of Paragraph 18, and on that basis, denies those allegations.

1 19. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
2 allegations of Paragraph 19, and on that basis, denies those allegations.

3 20 Matrox Tech lacks information sufficient to form a belief as to the truth of the  
4 allegations of Paragraph 20, and on that basis, denies those allegations.

5 21. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
6 allegations of Paragraph 21, and on that basis, denies those allegations.

7 **COUNT 2**

8 22. Matrox Tech repeats its responses to the allegations in Paragraphs 1 through 15 of the  
9 Amended Complaint.

10 23. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
11 allegations of Paragraph 23, and on that basis, denies those allegations.

12 24. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
13 allegations of Paragraph 24, and on that basis, denies those allegations.

14 25. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
15 allegations of Paragraph 25, and on that basis, denies those allegations.

16 26. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
17 allegations of Paragraph 26, and on that basis, denies those allegations.

18 27. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
19 allegations of Paragraph 27, and on that basis, denies those allegations.

20 **COUNT 3**

21 28. Matrox Tech repeats its responses to the allegations in Paragraphs 1 through 15 of the  
22 Amended Complaint.

23 29. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
24 allegations of Paragraph 29, and on that basis, denies those allegations.

25 30. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
26 allegations of Paragraph 30, and on that basis, denies those allegations.

27 31. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
28 allegations of Paragraph 31, and on that basis, denies those allegations.

1 32. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
2 allegations of Paragraph 32, and on that basis, denies those allegations.

3 33. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
4 allegations of Paragraph 33, and on that basis, denies those allegations.

5 **COUNT 4**

6 34. Matrox Tech repeats its responses to the allegations in Paragraphs1 through 15 of the  
7 Amended Complaint.

8 35. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
9 allegations of Paragraph 35, and on that basis, denies those allegations.

10 36. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
11 allegations of Paragraph 36, and on that basis, denies those allegations.

12 37. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
13 allegations of Paragraph 37, and on that basis, denies those allegations.

14 38. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
15 allegations of Paragraph 38, and on that basis, denies those allegations.

16 39. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
17 allegations of Paragraph 39, and on that basis, denies those allegations.

18 **COUNT 5**

19 40. Matrox Tech repeats its responses to the allegations in Paragraphs1 through 15 of the  
20 Amended Complaint.

21 41. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
22 allegations of Paragraph 41, and on that basis, denies those allegations.

23 42. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
24 allegations of Paragraph 42, and on that basis, denies those allegations.

25 43. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
26 allegations of Paragraph 43, and on that basis, denies those allegations.

27 44. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
28 allegations of Paragraph 44, and on that basis, denies those allegations.

1 45. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
2 allegations of Paragraph 45, and on that basis, denies those allegations.

3 **COUNT 6**

4 46. Matrox Tech repeats its responses to the allegations in Paragraphs 1 through 15 of the  
5 Amended Complaint.

6 47. Matrox Tech denies each and every allegation in Paragraph 47 of the Amended  
7 Complaint.

8 48. Matrox Tech denies each and every allegation in Paragraph 48 of the Amended  
9 Complaint.

10 49. Matrox Tech denies each and every allegation in Paragraph 49 of the Amended  
11 Complaint.

12 50. Matrox Tech denies each and every allegation in Paragraph 50 of the Amended  
13 Complaint.

14 51. Matrox Tech denies each and every allegation in Paragraph 51 of the Amended  
15 Complaint.

16 **COUNT 7**

17 52. Matrox Tech repeats its responses to the allegations in Paragraphs 1 through 15 of the  
18 Amended Complaint.

19 53. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
20 allegations of Paragraph 53, and on that basis, denies those allegations.

21 54. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
22 allegations of Paragraph 54, and on that basis, denies those allegations.

23 55. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
24 allegations of Paragraph 55, and on that basis, denies those allegations.

25 56. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
26 allegations of Paragraph 56, and on that basis, denies those allegations.

27 57. Matrox Tech lacks information sufficient to form a belief as to the truth of the  
28 allegations of Paragraph 57, and on that basis, denies those allegations.

**DEFENSES**

In further response to the Amended Complaint, Defendant Matrox Tech asserts the following:

**FIRST AFFIRMATIVE DEFENSE: INVALIDITY**

58. The '432 Patent is invalid for failure to meet the requirements specified in Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, and 112 for one or more of the following reasons: (a) the inventor named in the '432 Patent did not invent or discover any new useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof within the meaning of 35 U.S.C. § 101; (b) the subject matter claimed in the '432 Patent was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before it was invented by the inventors named in the '432 Patent, as prohibited by 35 U.S.C. § 102(a); (c) the subject matter claimed in the '432 Patent was patented or described in a printed publication in this or a foreign country or was in public use or on sale in this country, more than one year prior to the filing of the application which resulted in the '432 Patent in the United States, as prohibited by 35 U.S.C. § 102(b); (d) the subject matter claimed in the '432 Patent was described in a United States patent based on an application filed in the United States or described in an application published prior to its invention by the inventors named in the '432 Patent, as prohibited by 35 U.S.C. § 102(e); (e) the inventor named in the '432 Patent did not invent the subject matter; (f) the subject matter claimed in the '432 Patent was invented in this country by another inventor, who did not abandon, suppress or conceal it, before its invention by the inventors named in the '432 Patent, as prohibited by 35 U.S.C. § 102(g); (g) the subject matter claimed in the '432 Patent would have been obvious, in view of the prior art, to a person having ordinary skill in the art at the time the invention was made under 35 U.S.C. § 103; and/or (h) the claims of the '432 Patent are invalid for failing to comply with 35 U.S.C. § 112, in that (i) the specification fails to contain a written description of the subject matter claimed in the '432 Patent and the manner and process of making and using it; (ii) the claims fail to particularly point out and distinctly claim a patentable invention, (iii) the claims are indefinite, (iv) the specification fails to enable one skilled in the art to practice the claimed invention, and/or (v) the specification fails to set forth the best mode contemplated by the named

1 inventors for carrying out the alleged invention. Defendant reserves the right to amend this defense  
2 further, as additional information is developed through discovery or otherwise.

3 **SECOND AFFIRMATIVE DEFENSE: NONINFRINGEMENT**

4 59. Matrox Tech has not used within the United States any processes that infringe any valid  
5 claim of the '432 Patent, either directly, indirectly, contributorily or otherwise, and has not induced  
6 others to infringe any valid claim of the '432 Patent.

7 60. Matrox Tech has not offered to sell, sold, and/or imported within the United States any  
8 product made by a process that infringes any valid claim of the '432 Patent, either directly, indirectly,  
9 contributorily, or otherwise, and has not induced others to infringe any valid claim of the '432 Patent.

10 **THIRD AFFIRMATIVE DEFENSE: LACHES**

11 61. Between 1991 and 2001 Plaintiff Ricoh and Knowledge Based Silicon Corporation  
12 ("KBS") were co-assignees of the '432 patent. Pursuant to agreement, Ricoh paid the maintenance  
13 fees for the '432 patent. On information and belief, Ricoh and KBS coordinated all activities related to  
14 the '432 patent.

15 62. In or about 1991, KBS unsuccessfully tried to persuade Synopsys, Inc. ("Synopsys"), to  
16 license the '432 Patent. KBS subsequently abandoned those efforts, and instead developed and  
17 marketed products that were interoperable with Synopsys' Design Compiler product. Towards this  
18 end, KBS acquired a license to Design Compiler and received assistance from Synopsys to make its  
19 products interoperable with the Design Compiler software. At no point during these cooperative  
20 efforts did KBS make any allegation that Synopsys' Design Compiler software, or any other Synopsys  
21 product, was infringing the '432 Patent.

22 63. Matrox Tech purchased the Design Compiler software from Synopsys.

23 64. Plaintiff is barred from recovery of damages by reason of laches.

24 **FOURTH AFFIRMATIVE DEFENSE: IMPLIED LICENSE**

25 65. Plaintiff is barred from obtaining any relief sought in the Am ended Complaint by  
26 reason of the existence of an implied license to practice the claims of the '432 Patent between Plaintiff  
27 and Synopsys. Plaintiff s action against Matrox Tech is barred by the doctrine of patent exhaustion.



**FIFTH AFFIRMATIVE DEFENSE: PROSECUTION HISTORY ESTOPPEL**

66. By reason of the arguments presented during the prosecution of the applications for the '432 Patent in the United States Patent and Trademark Office, Ricoh is estopped from construing the claimed inventions of such patent (or any equivalent thereof) as applying to any product made, used, sold, or offered for sale by Matrox Tech.

**RESERVATION OF AFFIRMATIVE DEFENSES**

67. With discovery still ongoing, Matrox Tech has yet to complete its investigation. Matrox Tech reserves the right to assert any other defenses that discovery may reveal, including unclean hands or inequitable conduct.

**COUNTERCLAIMS**

Counterplaintiff Matrox Tech, Inc. ("Matrox Tech"), for its counterclaims against Counterdefendant Ricoh Company, Ltd. ("Rico"), alleges as follows:

**PARTIES**

68. Matrox Tech is a corporation organized under the laws of Delaware, and maintains its principal place of business at 1075 Broken Sound Parkway, NW Boca Raton, FL 33487-3524.

69. Upon information and belief, Ricoh is a corporation organized under the laws of Japan, having its principal place of business at 3 -6 1-chome, Nakamagome, Tokyo, Japan.

**JURISDICTION AND VENUE**

70. Counts 1 through 2 of the counterclaims are based upon the Patent Laws of the United States, Title 35 of the United States Code, §1 *et seq.* The Court has jurisdiction over the counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

71. Ricoh has submitted to the personal jurisdiction of this Court, because suit was filed in this district by Counterdefendant Ricoh.

72. Venue is proper in this district pursuant to 28 U.S.C. § 1391, because suit was filed in this district by Counterdefendant Ricoh.

73. There is an actual justifiable case or controversy between Matrox Tech and Ricoh, in this district, arising under the Patent Laws, 35 U.S.C. § 1 *et seq.* This case or controversy arises by virtue of Ricoh's filing of this suit which purports to allege that Matrox Tech infringes U.S. Patent No.

1 4,922,432 (“the ‘432 Patent”) and Matrox Tech’s Answer thereto, which asserts the invalidity and  
 2 noninfringement of the ‘432 Patent.

### 3 COUNT 1

#### 4 DECLARATORY JUDGMENT OF INVALIDITY

5 74. Matrox Tech incorporates by reference Paragraphs 1-72 into this count as though fully  
 6 set forth herein.

7 75. The ‘432 Patent, entitled “Knowledge Based Method and Apparatus for Designing  
 8 Integrated Circuits using Functional Specifications” issued on May 1, 1990. Ricoh purports to be the  
 9 owner of the ‘432 Patent.

10 76. Ricoh has sued Matrox Tech in the present action, alleging infringement of the ‘432  
 11 Patent.

12 77. Based on Paragraph 58 above, which is specifically incorporated by reference into this  
 13 Paragraph, the ‘432 Patent is invalid.

14 78. Matrox Tech requests declaratory judgment that the ‘432 Patent is invalid.

### 15 COUNT 2

#### 16 DECLARATORY JUDGMENT OF NONINFRINGEMENT

17 79. Matrox Tech incorporates by reference Paragraphs 1-78 into this count as though fully  
 18 set forth herein.

19 80. Based on Paragraphs 59 and 60 above, which are specifically incorporated by reference  
 20 into this Paragraph, the ‘432 Patent is not infringed by Matrox Tech.

21 81. Matrox Tech requests declaratory judgment that Matrox Tech has not infringed the ‘432  
 22 Patent.

### 23 RESERVATION OF COUNTERCLAIMS

24 82. Matrox Tech reserves the right to assert any other counterclaims that discovery may  
 25 reveal, including, but not limited to, claims arising out of false or misleading statements to the public  
 26 and/or customers.

### 27 PRAYER FOR RELIEF

28 WHEREFORE, Matrox Tech respectfully prays for the following relief:

- 1 A. that this Court deny and all relief requested by Plaintiff in its Amended Complaint and  
2 any relief whatsoever, and that the Amended Complaint be dismissed with prejudice;  
3 B. that this Court declare the '432 Patent invalid;  
4 C. that this Court declare the '432 Patent unenforceable;  
5 D. that this Court declare that Matrox Tech has not infringed any valid claim of the '432  
6 Patent;  
7 E. that this Court declare the case to be exceptional pursuant to 35 U.S.C. § 285 and that  
8 costs of his action and attorneys' fees be awarded to Matrox Tech;  
9 F. that this Court grant such other and further relief to Matrox Tech as this Court may  
10 deem just and equitable and as the Court deems appropriate.

11 **DEMAND FOR JURY TRIAL**

12 Defendant Matrox Tech hereby demands trial by jury in this action.

13 Dated: April 7, 2006

Respectfully submitted,

14 HOWREY LLP

15  
16 By: /s/Denise M. De Mory  
Denise M. De Mory  
17 Attorneys for Defendants  
18 AEROFLEX, INC., MATROX TECH  
19 SEMICONDUCTOR, INC., MATROX  
20 ELECTRONIC SYSTEMS, LTD.,  
21 MATROX GRAPHICS INC., MATROX  
22 INTERNATIONAL CORP., MATROX  
23 TECH, INC. AND  
24 AEROFLEX COLORADO SPRINGS,  
25 INC.  
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